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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,436

02/17/2004

Michele L. Ricks

87443RLO

2002

7590
Pamela R. Crocker
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

12/20/2006

EXAMINER

GARRETT, DAWN L

ART UNIT

PAPER NUMBER

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/20/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/780,436

Applicant(s)

RICKS ET AL.

Examiner

Dawn Garrett

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-18 and 24-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-18 and 24-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 18, 2006 has been entered.
2. The amendment filed October 5, 2006 has now been entered as requested in the request for continued examination filed October 18, 2006. Claims 1, 3, and 24 were amended. Claims 2 and 19-23 were cancelled. Claims 1, 3-18 and 24-35 are pending.
3. The terminal disclaimer filed on October 5, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Application No. 10/950,614 has been reviewed and is accepted. The terminal disclaimer has been recorded.
4. The rejection of claims 1-24, 27-29, and 31 under 35 U.S.C. 103(a) as being unpatentable over Hatwar (EP 1187235 A2) in view of Aziz et al. (US 2004/0018380 A1) is withdrawn due to the amendment of independent claim 1.
5. The rejection of claims 28 and 30 under 35 U.S.C. 103(a) as being unpatentable over Hatwar (EP 1187235 A2) in view of Aziz et al. (US 2004/0018380 A1) in further view of Fukuoka et al. (US 6,803,120) is withdrawn due to the amendment of independent claim 1.

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6. The rejection of claims 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Hatwar (EP 1187235 A2) in view of Aziz et al. (US 2004/0018380 A1) in view of Hoag et al. (EP 1340798) is withdrawn due to the amendment of independent claim 1.

7. The rejection of claims 3, 24, and 26 under 35 U.S.C. 103(a) as being unpatentable over Hatwar (EP 1187235 A2) in view of Aziz et al. (US 2004/0018380 A1) in view of Hosokawa et al. (US 5,121,029) is withdrawn due to the amendment of independent claim 1.

8. The rejection of claims 32-35 under 35 U.S.C. 103(a) as being unpatentable over Hatwar (EP 1187235 A2) in view of Aziz et al. (US 2004/0018380 A1) in further view of Wolk et al. (US 6,194,119) is withdrawn due to the amendment of independent claim 1.

9. The rejection of claims 1, 4-18, 22, 23, 24, 27, 28, and 31 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/950,614 is withdrawn due to the Terminal Disclaimer filed October 5, 2006.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1, 3-18, and 24-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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It is not seen where the specification supports the added limitation that cohost material (NPB) is added in a range of 1-20% of both host materials. Applicant states in the remarks that support may be found in the Examples of the specification; however, the specification examples appear to only support the range of 4-10% NPB (see Table 1 and Examples). In the absence of clear support for the range 1-20% of both host materials, the limitation is considered to be new matter.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1, 3-18, and 24-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites NPB is in a range of 1-20% of both host materials, but it is not clear if the range is in terms of weight % or volume %. Clarification and/or correction are required.

Allowable Subject Matter

14. The pending claims appear to comprise allowable subject matter in terms of the prior art, but it is noted that all claims are currently rejected under 35 U.S.C. 112, first and second paragraph, as set forth in this Office action.

Response to Arguments

15. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (571) 272-1523. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dawn Garrett
Primary Examiner
Art Unit 1774

December 14, 2006